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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,837	08/09/2006	K. Donald Evans	14216.16	6962
21999 7590 11/14/2008 KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111				
EXAMINER MC GINTY, DOUGLAS J				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/597,837

Applicant(s)

EVANS ET AL.

Examiner

DOUGLAS MC GINTY

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29, 31-40 and 46-50 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 29, 31-40 and 46-50 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8-9-08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 29, 37, and 40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 25, 30, and 35, respectively, of copending Application No. 11 535 896.

Claims 29, 37, and 40 appear to be identical to claims 25, 30, and 35 of 11 535 896. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29, 31-40, and 46-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-40 of copending Application No. 11 535 896.

To the extent the conflicting claims are not identical, they also are not patentably distinct from each other because the claims of the other application pertain to a method of providing cleaning agent to a cleaning machine. As discussed above, present claims 29, 37, and 40 appear to be identical to claims in the other application and thus are subject to a double patenting rejection under 35 USC 101. Those claims, as well as the other claims in the present application, also would be obvious over the claims of the other application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 29, 31-40, and 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scepanski (US 2002,0006891) in view of Laughlin (US 5,342,587).

Scenpanski teaches a method of providing laundry cleaning agent to a laundry cleaning machine (Fig. 1, Abstract). The composition may contain perborates and/or percarbonates [0090, 0095]. Potassium silicate also may be added [0060].¹ The reference also teaches that the cleaning agent is dissolved in water in a plurality of

¹ The reference still teaches the presence of potassium silicate, even though it does not call it a "gas-releasing component". MPEP 2145, II.

laundry wash and rinse cycles [0104-0108]. In its *dissolved* state, the device is deposited within the laundry cleaning machine tub.

Scenpanski does not appear to teach that a "substantially consistent quantity of cleaning agent" is dispensed "over a plurality of laundry wash and rinse cycles".

Nevertheless, Scenpanski incorporates the teachings of Laughlin by reference. Laughlin teaches controlling the dissolving process to ensure that the correct amount of properly diluted cleaning agent is dispensed (col. 2, line 46, through col. 3, line 2). The teaching of a properly diluted amount is deemed to meet the presently claimed limitation of a "substantially consistent quantity of cleaning agent".

It would have obvious for a method of providing laundry cleaning agent to a laundry cleaning machine, as taught by Scenpanski, to dispense substantially consistent quantities per wash and rinse cycle, as taught by Laughlin, because Scenpanski incorporates Laughlin by reference as to the teachings on the dispensing device.

With respect to claims 31-35 and 50, Laughlin teaches disposing the solid cleaning agent with a pliable plastic container, i.e., bag (col. 1, lines 12-19). The structure of that bag would been an obvious matter of design. MPEP 2144.04, VI.

With respect to claim 36, the absence of cleaning agent would have signaled the need to replace the cleaning device.

With respect to claim 37, the shape of the cleaning agent would have been an obvious matter of design. MPEP 2144.04, IV.B.

With respect to claims 38 and 40, Scenpanski teaches overlapping amounts of the components claimed [0059, 0088].

With respect to claims 39, 46, and 47, Scenpanski teaches various optional ingredients and alkalinity agents [0060, 0096].

With respect to claim 48, Scenpanski teaches multiple uses, the number of which would have been an obvious function of the capacity of the device.

With respect to claim 49, more of the device would be dissolved into the tub with each wash and rinse cycle.

Claims 29, 31-40, and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (US 6,301, 733) in view of Scepaniski (Us 2002/0006891).

Dawson teaches a method of providing laundry cleaning agent to a laundry cleaning machine (Abstract and Fig. 1). The multiuse device is porous and appears to be in the shape of a ball (Abstract and Fig. 1). The device may include a tablet which is consumed during the wash and rinse cycle (Abstract). Since the tablets are uniform in size, a substantially consistent quantity of cleaning agent is dispensed over a plurality of wash and rinse cycles. The device is placed within the laundry cleaning machine tub and exposed to water during washing and rinsing.

Dawson does not appear to teach the presence of perborates and /or percarbonates, nor does it appear to teach the use of potassium silicate.

Nevertheless, as discussed above, Scenpanski teaches the use of perborates and/or percarbonates in solid laundry detergents [0090, 0095] as well as potassium silicate [0060].

It would have been obvious for a method of providing laundry cleaning agent, as taught by Dawson, to include perborates and/or percarbonates, as well as potassium silicates, as taught by Scenpanski, because both references pertain to laundry cleaning. "The combination of familiar [components] according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). Obviousness only requires a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 904 (Fed. Cir. 1988). See also, MPEP 2143.02.

With respect to claims 31-35 and 50, Fig. 1 in Dawson appears to teach a device in the form of a ball. The structure of that device would be an obvious matter of design. MPEP 2144.04, VI. The device also would have been expected to diminish in size to some degree as the tablet dissolves, especially if the tablet was forced into the device.

With respect to claim 36, the absence of cleaning agent would have signaled the need to replace the cleaning device.

With respect to claim 37, the shape of the cleaning agent would have been an obvious matter of design. MPEP 2144.04, IV.B.

With respect to claims 38 and 40, Scenpanski teaches overlapping amounts of the components claimed [0059, 0088].

With respect to claims 39, 46, and 47, Scenpanski teaches various optional ingredients and alkalinity agents [0060, 0096].

With respect to claim 48, Dawson teaches multiple uses.

With respect to claim 49, the operator of ordinary skill would have had the choice of storing the device in or out of the tub.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS MC GINTY whose telephone number is (571)272-1029. The examiner can normally be reached on M-F, 830-500.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOUGLAS MC GINTY/
Primary Examiner, Art Unit 1796

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